

Application No.: 10/713174

Case No.: 58627US002

REMARKS

Claims 13-35 have been canceled from the application. Applicants reserve the right to pursue the subject matter of these claims in a divisional application.

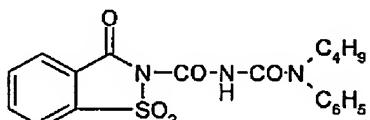
Claims 1, 3, 4, 5, and 6 currently amended. New claims 36-42 are added.

Claims 1-12 and 36-42 are pending.

Rejections based on USC § 102(b)

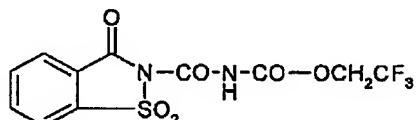
The Examiner rejected claims 1-12 for alleged anticipation by U.S. Patent No. 4,713,389 (hereinafter “US ‘389”) of Salzburg et al. More specifically, the Examiner rejected claims 1-12 based on the compounds disclosed in Examples 3, 5, and 11 of this reference. Applicants respectfully submit that the pending claims are novel over this reference.

Example 3 of US ‘389 discloses the following compound that does not fall within the scope of pending claim 1.



The pending claims recite that Y¹ comprises at least one heteroalkylene, alkylene, or combinations thereof. In contrast, Example 3 lacks such a group.

Example 5 of US ‘389 discloses the following compound that does not fall within the scope of pending claim 1.

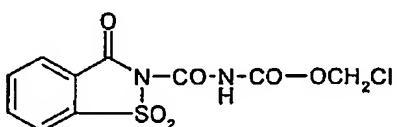


The pending claims recite that Y¹ comprises at least one heteroalkylene, alkylene, or combinations thereof. In contrast, Example 5 lacks such a group. Additionally, the pending claims do not recite a haloalkyl group for X¹.

Example 11 of US ‘389 discloses the following compound that does not fall within the scope of pending claim 1.

Application No.: 10/713174

Case No.: 58627US002



The pending claims recite that Y^1 comprises at least one heteroalkylene, alkylene, or combinations thereof. In contrast, Example 11 lacks such a group. Additionally, the pending claims do not recite a haloalkyl group for X^1 .

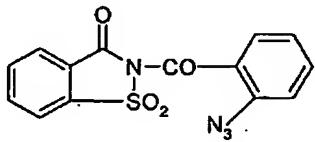
Thus, the pending claims are novel over US'389. Applicant respectfully requests withdrawal of the rejection based on this reference.

The Examiner rejected claims 1-12 for alleged anticipation by U.S. Patent No. 2,995,542 (hereinafter "US '542") of Brown et al. More specifically, the Examiner rejected pending claims 1-12 based on seven compounds shown in columns 7 and 8 of this reference. Applicants respectfully submit that the pending claims are novel over this reference.

All the compounds disclosed in US '542 have an ethylenically unsaturated group. The pending claims do not recite an ethylenically unsaturated group for X^1 . Thus, the pending claims are novel over US '542. Applicants respectfully request withdrawal of the rejection based on this reference.

The Examiner rejected claims 1-12 for alleged anticipation by the article in *Tetrahedron Letters* by Luheshi et al. More specifically, the Examiner rejected pending claims 1-12 based on compound (4) in this reference. Applicants respectfully submit that the pending claims are novel over this reference.

Compound (4) is shown below.



The pending claims recite that Y^1 comprises at least one heteroalkylene, alkylene, or combinations thereof. In contrast, Compound 4 in the article by Luheshi et al. lacks such a

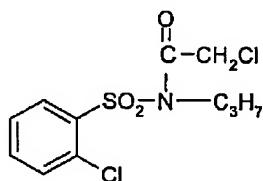
Application No.: 10/713174

Case No.: 58627US002

group. Thus, the pending claims are novel over this reference and Applicants respectfully request withdrawal of the rejection based on this reference.

The Examiner rejected claims 1-12 for alleged anticipation by JP 03157360 (hereinafter "JP '360") of Hashimoto et al., as reported in CAS 115:207678. Applicants respectfully submit that the pending claims are not anticipated by this reference.

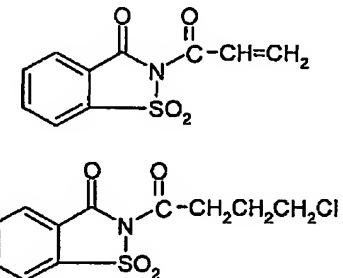
This reference discloses the following compound.



The pending claims do not recite an X¹ group equal to a haloalkyl or halo. Thus, the pending claims are novel over JP '360 and Applicants respectfully request withdrawal of the rejection based on this reference.

The Examiner rejected claims 1-12 for alleged anticipation by JP 47043332 (hereinafter "JP '332") of Chiyamaru et al., as reported in CAS 78:144282. Applicants respectfully submit that the pending claims are not anticipated by this reference.

This reference discloses the following compounds.



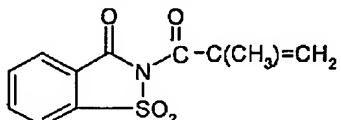
The pending claims do not recite a X¹ group equal to a haloalkyl or equal to an ethylenically unsaturated group. That is, this reference does not disclose a X¹ group within the scope of the pending claims. Thus, the pending claims are novel over JP '332 and Applicants respectfully request withdrawal of the rejection based on this reference.

Application No.: 10/713174

Case No.: 58627US002

The Examiner rejected claims 1-12 for alleged anticipation by the article in *Yuki Gosei Kagaku Kyokaishi* by Kato et al., as reported in CAS 78:124224. Applicants respectfully submit that the pending claims are not anticipated by this reference.

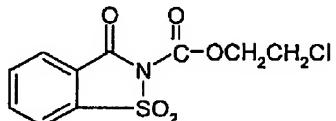
This reference discloses the following compound.



The pending claims do not recite an X¹ group equal to an ethylenically unsaturated group. That is, this reference does not disclose an X¹ group within the scope of the pending claims. Thus, the pending claims are novel over this reference and Applicants respectfully request withdrawal of the rejection based on this reference.

The Examiner rejected claims 1-12 for alleged anticipation by JP 49020779 (hereinafter "JP '779") of Chiyomaru et al., as reported in CAS 82:140119. Applicants respectfully submit that the pending claims are not anticipated by this reference.

This reference discloses the following compound.



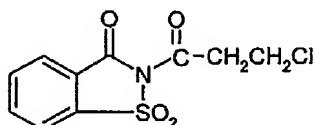
The pending claims do not recite an X¹ group equal to a haloalkyl. That is, JP '779 does not disclose an X¹ group within the scope of the pending claims. Thus, the pending claims are novel over this reference and Applicants respectfully request withdrawal of the rejection based on this reference.

The Examiner rejected claims 1-12 for alleged anticipation by JP 47020158 (hereinafter "JP '158") of Chiyomaru et al., as reported in CAS 77:164667. Applicants respectfully submit that the pending claims are not anticipated by this reference.

JP '158 discloses the following compound.

Application No.: 10/713174

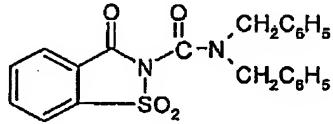
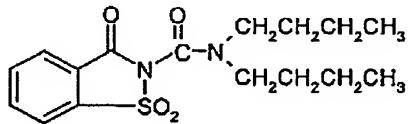
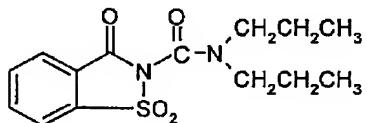
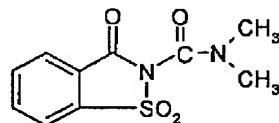
Case No.: 58627US002



The pending claims do not recite an X¹ group equal to a haloalkyl. That is, JP '158 does not disclose an X¹ group within the scope of the present claims. Thus, the pending claims are novel over this reference and Applicants respectfully request withdrawal of the rejection based on this reference.

The Examiner rejected claims 1-12 for alleged anticipation by JP 46036613 (hereinafter "JP '613") of Mine et al., as reported in CAS 76:14533. Applicants respectfully submit that the pending claims are not anticipated by this reference.

JP '613 discloses the following compounds.



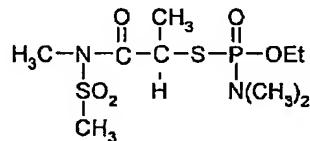
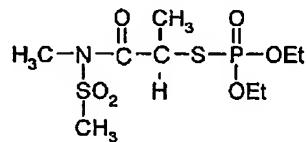
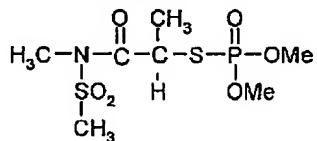
The pending claims recite that Y¹ comprises at least one heteroalkylene, alkylene, or combinations thereof. That is, the Y¹ group is not equal to a single bond and JP '613 does not include a Y¹ group within the scope of the pending claims. Thus, the pending claims are novel over JP '613 and Applicants respectfully request withdrawal of the rejection based on this reference.

Application No.: 10/713174

Case No.: 58627US002

The Examiner rejected claims 1-12 for alleged anticipation by the publication by Mandel'baum et al. in *Khimicheskie Sredstva Zashchity Rastenii*, as reported in CAS 82:57814. Applicants submit that the pending claims are novel over this reference.

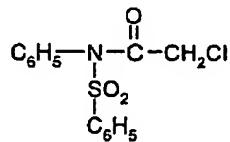
More specifically, this reference discloses the following compounds.



As defined in independent claim 1, Y¹ does not include a thio group. That is, this reference does not disclose a Y¹ group within the scope of the pending claims. Thus, the pending claims are novel over this reference and Applicants respectfully request withdrawal of the rejection based on this reference.

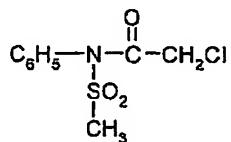
The Examiner rejected claims 1-12 for alleged anticipation by JP 54090117 (hereinafter "JP '117") of Iwakura et al., as reported in CAS 92:41570. Applicants respectfully submit that the pending claims are not anticipated by this reference.

JP '117 discloses the following compounds.



Application No.: 10/713174

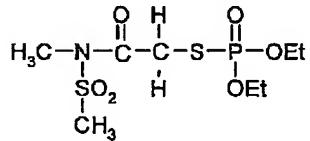
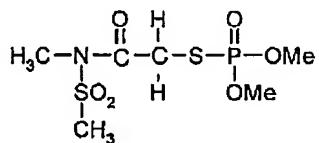
Case No.: 58627US002



As defined in the independent claims, X¹ does not include a haloalkyl. That is, the compounds of JP '117 do not have an X¹ group within the scope of the pending claims. Thus, the pending claims are novel over JP '117 and Applicants respectfully request withdrawal of the rejections based on this reference.

The Examiner rejected claims 1-12 for alleged anticipation by DE 1152407 (hereinafter "DE '407") of Schrader, as reported in CAS 60:3301. Applicants respectfully submit that the pending claims are not anticipated by this reference.

DE '407 discloses the following compounds.



As defined in independent claim 1, Y¹ does not include a thio group. The compounds in DE '407 do not have a Y¹ group within the scope of the pending claims. Thus, the pending claims are novel over DE '407 and Applicants respectfully request withdrawal of the rejection based on this reference.

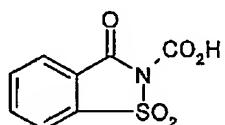
Rejection based on § 102(a)

The Examiner rejected claims 1-12 for alleged anticipation by the article of Naumov et al. in *Solid State Sciences*, as reported in CAS 137:83888. Applicants respectfully submit that the pending claims are not anticipated by this reference.

This reference discloses the following compound.

Application No.: 10/713174

Case No.: 58627US002

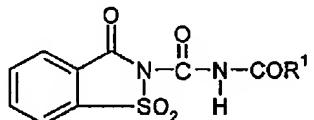


As defined in independent claim 1, Y¹ includes at least one heteroalkylene, alkylene, or combinations thereof. The compound in this reference lacks such a Y¹ group. Thus, the pending claims are novel over this reference and Applicants respectfully request withdrawal of the rejection based on this reference.

Rejections based on 35 USC § 103(a)

The Examiner rejected claims 1-12 for alleged obviousness over U.S. Patent No. 4,713,389 (hereinafter “US ‘389”) of Salzburg et al. Applicants respectfully submit that the pending claims are not obvious over this reference.

The following formula is disclosed in US ‘389.



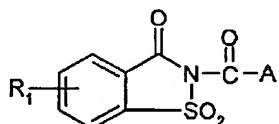
In this formula, the group R¹ is either a halogenated alkyl or a group of formula -NR³R⁴. The pending claims are not obvious over this formula. First of all, the compounds of this formula lack a Y¹ group within the scope of the pending claims. That is, the pending claims recite that Y¹ comprises a heteroalkylene, alkylene, or combinations thereof. Further, when R¹ is a halogenated alkyl, the compounds lack a X¹ group within the scope of the pending claims.

There is no motivation in this reference for making any compounds other than those disclosed. That is, there is no motivation or suggestion to make the compounds of the pending claims. The pending claims are not obvious over this reference. Applicants respectfully request withdrawal of the obviousness rejection based on US ‘389.

The Examiner rejected claims 1-12 for alleged obviousness over U.S. Patent No. 4,195,023 (hereinafter “US ‘023”) of Mulvey et al. Applicants respectfully submit that the pending claims are not obvious over this reference.

Application No.: 10/713174

Case No.: 58627US002



In this formula, A can be an alkenyl having 2 to 5 carbon atoms. These compounds do not have a X¹ group within the scope of the pending claims. That is, the recited X¹ groups do not include an alkenyl such as an ethylenically unsaturated group. Further, as the Examiner noted, Y¹ would be a single bond when A had only two carbon atoms; this value of Y¹ is not within the scope of the pending claims.

There is no motivation or suggestion in this reference for making any compounds other than those disclosed. That is, there is no motivation or suggestion to make the compounds of the pending claims. The pending claims are not obvious over this reference. Applicants respectfully request withdrawal of the obviousness rejection based on US '023.

The Examiner rejected claims 1-12 for alleged obviousness over U.S. Patent 2,995,542 (hereinafter "US '542") of Brown. Applicants respectfully submit that the pending claims are not obvious over this reference.

As discussed above, all the compounds disclosed in US '542 have an ethylenically unsaturated group. The pending claims do not recite an ethylenically unsaturated group for X¹.

There is no motivation or suggestion in this reference for making any compounds other than those disclosed. That is, there is no motivation to make the compounds with other X¹ groups that can be reacted with a group on the surface of a substrate. The pending claims are not obvious over this reference. Applicants respectfully request withdrawal of the obviousness rejection based on US '542.

The Examiner rejected claims 1-12 for alleged obviousness over JP 03157360 (hereinafter "JP '360") of Hashimoto et al., as reported in CAS 115:207678. Applicants respectfully submit that the pending claims are not obvious over this reference.

As discussed above, the compounds disclosed in JP '360 include a haloalkyl group. The pending claims do not recite a haloalkyl group for X¹.

Application No.: 10/713174Case No.: 58627US002

There is no motivation or suggestion in this reference for making any compounds other than those disclosed. That is, there is no motivation to make the compounds with other X¹ groups that can be reacted with a group on the surface of a substrate. The pending claims are not obvious over this reference.

Double Patenting

The Examiner provisionally rejected claims 1-12 based on non-statutory double patenting over copending patent application No. 10/987,522, which corresponds to U.S. Patent Application Publication 2005/0112672 A1. The Examiner alleges that the conflicting claims are not patentably distinct from each other. Applicants respectfully disagree.

As correctly noted by the examiner, the pending claims in the U.S. Patent Application No. 10/987,522 include an ethylenically unsaturated group. In contrast, the pending claims have been amended to remove an ethylenically unsaturated group from the recitation of X¹. Thus, there is no overlap between the present patent application and U.S. Patent Application No. 10/987,522. Applicants respectfully request withdrawal of this provisional double patenting rejection.

In view of the above, it is submitted that the application is in condition for allowance. A Notice of Allowance of claims 1-12 and 36-42 is earnestly solicited.

Respectfully submitted,

April 11, 2006
Date

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